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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,201	06/05/2006	Karlheinz Ulrich Gerhard Hahn	102792-567 (11337P4 US)	7110

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NORRIS, MCLAUGHLIN & MARCUS
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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,201

Applicant(s)

HAHN ET AL.

Examiner

Joseph D. Anthony

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13 and 18-20, drawn to a composition comprising zinc and bismuth.

Group II, claim(s) 14-17, drawn to a method of protecting glassware in an automatic dishwashing machine.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, their shared corresponding special technical features do not define a contribution over the prior-art (i.e. the special technical feature(s) is/are anticipated in view of the following prior-art references. Umeda et al. U.S. Patent Application Publication No.: 2003/0052299A1 or Dumesnil et al. U.S. Patent Number 4,743,302 or Beck et al. U.S. Patent number 2,726,161

During a telephone conversation with Andrew N. Parfomak on 12/04/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim.

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishida et al. U.S. Patent Number 7,261,760.

Ishida et al. teaches metal alloys that may comprise bismuth and zinc.

Applicant's claims are deemed to be anticipated over the alloys labeled 4-10 and 4-11 in Table 5.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Takaoka et al. U.S. Patent Application Publication No.: 2002/0012608A1.

Takaoka et al. teach lead free solder compositions and soldered articles.

Applicant's claims are deemed to be anticipated over the solder compositions set forth in examples 10 and 12, and comparative examples 10 and 12 in Table 1.

Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takaoka et al. U.S. Patent Application Publication No.: 2002/0012608A1...

Takaoka et al. has been described above and is deemed to anticipate applicant's claimed invention because of the references direct concentration disclosures of zinc as set forth in sections [0012]-[0013]. In the alternative, since there is not a direct teaching (i.e. by way of an example) to a solder composition that comprises zinc to bismuth within application claimed ratio, it would have been obvious to one having ordinary skill in the art to use said broad concentration disclosure of zinc as motivation to use an amount of zinc that would meet applicant's claimed zinc to bismuth mass concentration ratio.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Moon U.S. Patent Number 4,025,944.

Moon teaches p-type indium phosphide with a bismuth-zinc alloy pellet attachment. Applicant's claims are deemed to be anticipated over the bismuth-zinc alloy pellet attachment as set forth in figure 1

Claims 1-3, 6-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Umeda et al. U.S. Patent Application Publication No.: 2003/0052299A1 or Dumesnil et al. U.S. Patent Number 4,743,302 or Beck et al. U.S. Patent number 2,726,161.

Umeda et al. teach sintered body and high-frequency circuit component. Applicant's claims are deemed to be anticipated over the sintered bodies in Table 4 that contain in part in zinc oxide and bismuth oxide.

Dumesnil et al. teach low melting glass compositions. Applicant's claims are deemed to be anticipated over examples 1-8 that contain in part zinc oxide and bismuth oxide.

Beck et al. teach high-index glass elements. Applicant's claims are deemed to be anticipated over examples 14-18 in Table I that comprise in part zinc oxide and bismuth oxide.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil et al. U.S. Patent Number 4,743,302.

Dumesnil et al has been described above and differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a glass composition that comprise zinc oxide, bismuth oxide and an aluminum oxide. It would have been obvious to one having ordinary skill in the art to use the disclosure of example 13 wherein aluminum oxide is used in combination with zinc oxide in a glass composition, as motivation to actually add aluminum oxide as an optional component to the zinc oxide and bismuth oxide containing glass compositions directly taught by the patent.

Claims 1-3, 6-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 070 587.

EP teaches rinse aid compositions for automatic dishwashing machines that comprise surfactants, chelating agent, builders, and water-soluble salts selected from

the group consisting of magnesium, zinc, tin, bismuth, titanium and mixtures thereof, see abstract, the bridging paragraph at the bottom of page 2 to the top of page 3, example 1 and claim 1. EP differs from applicant's claimed invention in that there is not a direct teaching (i.e. by way of an example) to a rinse aid composition that actually comprises both a zinc soluble salt and a bismuth soluble salt. It would have been obvious to one having ordinary skill in the art to use the direct disclosure of the reference's claim 1, as strong motivation to actually make a rinse aid composition that comprised both a zinc soluble salt and a bismuth soluble salt. Furthermore, the courts have constantly declared that to employ two or more materials in combination for the same purpose they are taught as being individually useful is not patentable outside a shown of unexpected and superior results, see *In re Kerhoven*, 205 USPQ 1069 (CCPA 1980). The further inclusion of aluminum, as required in applicant's claim 18, is deemed to be obvious over EP in light of EP's disclosure that aluminum salts are well known optional components in rinse aid compositions, see the bridging paragraph at the bottom of page 2 to the top of page 3.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/558,211. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is massive overlap in the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 6-13 and 18-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-8, 10 and 12-14 of copending Application No. 10/468,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap in the claimed subject matter in light of the specifications of both pending applications. See especially Table GL-1b on page 12 of 10/575,201 and the whole

specification of 10/468,669 wherein the water-soluble glass compositions are disclosed to be useful in combination with detergents and other known components in rinse aids.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 6-13 and 18-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 10, 13-14 and 16-17 of copending Application No. 10/575,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap in the claimed subject matter in light of the specifications of both pending applications. See especially Table GL-1b on page 12 of 10/575,201 and the whole specification of 10/468,669 wherein the water-soluble glass compositions are disclosed to be useful in combination with detergents and other known components in rinse aids.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior-Art Cited But Not Applied

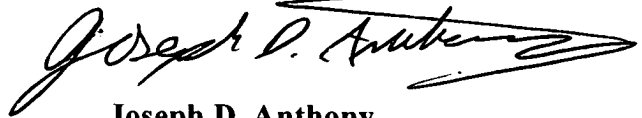
Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

A handwritten signature in black ink, appearing to read "Joseph D. Anthony", with a long horizontal flourish extending to the right.

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1796

12/8/07